

1 The opinion in support of the decision being entered today was *not* written  
2 for publication and is *not* binding precedent of the Board.

3  
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6  
7 BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

8  
9 *Ex parte* LAWRENCE F. GLASER

10  
11  
12 Appeal 2007-0922  
13 Application 09/270,710<sup>1</sup>  
14 Technology Center 3600

15  
16 Decided: March 21, 2007  
17

18  
19 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN and  
20 JENNIFER D. BAHR, *Administrative Patent Judges*.

21  
22 HUBERT C. LORIN, *Administrative Patent Judge*.

23  
24 DECISION ON APPEAL

25  
26  
27  
28 STATEMENT OF THE CASE

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<sup>1</sup>Filed 16 March 1999.

1 The appeal is from a decision of the Examiner rejecting claims 1-26  
2 over the prior art. 35 U.S.C. § 134 (2002). We have jurisdiction under 35  
3 U.S.C. § 6 (b) (2002).

4 We AFFIRM.

5 Appellants, in the Brief<sup>2</sup>, argue independent claims 1, 20, and 24  
6 separately. Pursuant to the rules, the Board selects representative claims 1,  
7 20 and 24 to decide the appeal. 37 CFR § 41.37(c)(1)(vii) (2005).  
8 Dependent claims stand or fall with their respective independent claims.

9 Claims 1, 20, and 24 read as follows:

10 1. A method of transmitting an advertisement from a  
11 sending party to a receiving party comprising the steps of:  
12 initiating a communication from a data processing system of a  
13 sending party;  
14 associating at least one pre-selected advertisement with said  
15 communication within the data processing system of the sending  
16 party; and  
17 transmitting said communication with said at least one  
18 advertisement embedded therein to the recipient.

19  
20 20. A method of transmitting an electronic communication  
21 including at least one advertisement from a data processing system of  
22 a sending party to a data processing system of a receiving party  
23 comprising the steps of:  
24 locating a data file containing signature information on the data  
25 processing system of the sending party, said signature information  
26 being appended to electronic communications originating from the  
27 sender's data processing system;

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<sup>2</sup> Our decision will make reference to Appellant's Appeal Brief ("Brief," filed 8 March 2006), the Examiner's Answer ("Answer," mailed 31 May 2006), and Appellants' Reply Brief ("Reply," filed 31 July 2006).

modifying the information stored within said signature file to include at least one advertisement; and

transmitting an electronic communication using the sender's data processing system to the data processing system associated with the recipient, said electronic communication including said information stored within said signature file including said at least one advertisement.

24. A method of transmitting an advertisement from a sending party to a receiving party comprising the steps of:

- initiating a communication from a data processing system of a sending party;
- associating at least one pre-selected advertisement with said communication within the data processing system of the sending party, wherein the pre-selected advertisement is under the local control of the sending party; and
- transmitting said communication with said one advertisement embedded therein to the recipient.

## ISSUES

The issue on appeal is whether Appellants have shown that the Examiner erred in concluding that a prima facie case of obviousness is made by the prior art.

## FINDINGS OF FACT - BACKGROUND

The following findings of fact (FF) are believed to be supported by at least a preponderance of the evidence.

- 1 1. The invention is directed to a method of transmitting an  
2 advertisement.
- 3 2. The Examiner finally rejected claims 1-19 and 23-25 as being  
4 unpatentable under 35 U.S.C. § 103 over Goldschmitt in view of  
5 Bezos (Answer 3).
- 6 3. The Examiner finally rejected claims 20-21, 22 and 26 as being  
7 unpatentable under 35 U.S.C. § 103 over Goldschmitt in view of  
8 Bezos and Uomini (Answer 8 with respect to claims 20-21 and 26 and  
9 Answer 12 with respect to claim 22).
- 10 4. WO 96/24213 (“Goldschmitt”) published on 8 August 1996 and  
11 therefore qualifies as prior art under 35 U.S.C. § 102(b).
- 12 5. Goldschmitt describes a method of transmitting an advertisement by  
13 email involving storing a subscriber’s email message in a mail server  
14 where, upon request of the email’s addressee, an advertisement is  
15 appended to the email message and the email, with the appended  
16 advertisement, is transmitted to the addressee for viewing.
- 17 6. U.S. Patent 6,029,141 (“Bezos”) issued on 22 February 2000 on an  
18 application filed on 27 June 1997 and therefore qualifies as prior art  
19 under 35 U.S.C. § 102(e).
- 20 7. Bezos describes a method of selling items from associate merchants  
21 involving a website with browsable web pages from which customers  
22 can electronically purchase items and which include hyperlinks to  
23 associate merchant’s websites.

1 8. U.S. Patent 6,018,761 (“Uomini”) issued on 25 January 2000 on an  
2 application filed on 11 December 1996 and therefore qualifies as  
3 prior art under 35 U.S.C. § 102(e).

4 9. Uomini describes a method of obtaining context information about an  
5 email sender using a mail processing program.  
6

7 FINDINGS OF FACT RE THE REJECTION OF CLAIM 1

8 10. The Examiner finds that

9 [a]s per claim 1, Goldschmitt discloses a method of  
10 transmitting an advertisement from a sending party to a receiving  
11 party (see abstract and Fig. 4) comprising the steps of:

- 12 • initiating a communication from a data processing  
13 system of the sending party (see Fig. 1 and page 8, line  
14 26 – page 9, line 2);
- 15 • [associating a preselected advertisement with said  
16 communication (page 9, lines 8-13); and,  
17 transmitting said communication with said at least one  
18 advertisement therein to the recipient (see abstract)[.]

19  
20 (Answer 3).

21 11. Appellant does not dispute this finding.

22 12. The Examiner finds that Goldschmitt differs from the claimed subject  
23 matter because

24 Goldschmitt does not explicitly disclose:

- 25 • embedding the advertisement within the  
26 communication[, and]
- 27 • associating the preselected advertisement with said  
28 communication within the user-managed data  
29 processing system[.]  
30

1 (Answer 3-4).

2 13. The Examiner relies on Bezos to show “embedding the advertisement  
3 within the communication and associating the preselected  
4 advertisement with said communication within the user-managed data  
5 processing system ...”. (Answer 4).

6 14. The Examiner finds that “[i]t would have been obvious to one of  
7 ordinary skill in the art at the time of Applicant’s invention to include  
8 the aforementioned limitations as disclosed by Bezos within  
9 Goldschmitt for the motivation of efficiently marketing and selling  
10 goods ...”. (Answer.4).

11 15. Appellant indicates that the Examiner’s finding with regard to the  
12 difference between the method claimed and that of Goldschmitt (see  
13 FF 12) is inaccurate, pointing out that claim 1 actually reads as  
14 follows:

15 associating at least one pre-selected advertisement with  
16 said communication within the data processing system of the  
17 sending party; and  
18 transmitting said communication with said at least one  
19 advertisement embedded therein to the recipient.  
20

21 (Br. 6).

22 16. Appellant contends that “Goldschmitt fails to teach, disclose or  
23 suggest at least the step of embedding the advertisement within the  
24 communication or associating at least one pre-selected advertisement  
25 with the communication within the data system of the sending party,  
26 as recited in claim 1.” (Br. 5).

1 17. Appellant contends that “Bezos fails to teach, disclose or suggest the  
2 step of embedding the advertisement within the communication or  
3 associating the pre-selected advertisement with said communication  
4 within the data processing of the sending party, as recited in claim 1.”  
5 (Brief 5).

6 18. Appellant further contends that “there is no suggestion or motivation  
7 to combine their respective teachings [and thus] their combination in  
8 the § 103(a) rejection is improper. (Brief 5).

9 19. Appellant argues that Bezos does “not have advertisements embedded  
10 [in the web pages selling products] as required by the pending claims  
11 ... contrary to the Examiner’s understanding, Bezos does not teach  
12 the association of advertisements in a communication and  
13 transmitting the communicating with the embedded advertisement to  
14 a recipient.” (Brief.8)(emphasis original).

15 20. Appellant argues that “Appellant has clearly distinguished a  
16 hyperlink from an embedded advertisement. That is, in Appellant’s  
17 claimed invention, referral hyperlinks are not themselves an  
18 advertisement, which is inherently different from the Examiner’s  
19 interpretation of the referral hyperlink of Bezos.” (Brief 11).

20  
21 FINDINGS OF FACT RE THE REJECTION OF CLAIM 24

22 21. Claim 24 differs from claim 1 in further defining the pre-selected  
23 advertisement as one which “is under the local control of the sending  
24 party.”

1 22. The Examiner finds that "Goldschmitt does not explicitly disclose  
2 wherein the pre-selected advertisement is under the local control of  
3 the sending party." (Answer 8).

4 23. The Examiner finds that "Bezos discloses the pre-selected  
5 advertisement is under the local control of the sending party."  
6 (Answer 8).

7 24. The Examiner finds that "[i]t would have been obvious to one of  
8 ordinary skill in the art at the time of Applicant's invention to include  
9 the aforementioned limitation as disclosed in Bezos within  
10 Goldschmitt for the motivation stated above for claim 1." (Answer.  
11 8).

12 25. Appellant's principal argument is that in limiting the pre-selected  
13 advertisement to one which is "under the local control of the sending  
14 party" the claimed method contrasts with the method of Goldschmitt  
15 because the Goldschmitt method involves the "appending of an  
16 advertisement to an email . . . performed at a remote mail server  
17 associated with the sponsors" whereas "claim 24 of the present  
18 invention recites, among other features, the pre-selected  
19 advertisement is under the control of the sending party." (Brief 12).

20  
21 FINDINGS OF FACT RE THE REJECTION OF CLAIM 20

22 26. The Examiner finds that

23 [a]s per claim 20, Goldschmitt discloses a method of  
24 transmitting an electronic communication including an advertisement  
25 from a user managed data processing system associated with a



1 sending party to a data processing system associated with a receiving  
2 party (abstract) comprising the steps of:

- 3 • transmitting an electronic communication using the data  
4 processing system associated with the sending party to the  
5 data processing system associated with the recipient (see  
6 abstract).

7  
8 (Answer 9).

9  
10 27. Appellant does not dispute this finding.

11 28. The Examiner finds that Goldschmitt differs from the claimed subject  
12 matter because

13 Goldschmitt does not explicitly disclose:

- 14 • embedding the advertisement within the  
15 communication[, and]
- 16 • associating the preselected advertisement with said  
17 communication within the user-managed data  
18 processing system wherein said at least one  
19 advertisement optionally includes a hyperlink[.]

20  
21 (Answer 9).

22  
23 29. The Examiner relies on Bezos to show “embedding the advertisement  
24 within the communication and associating the preselected  
25 advertisement with said communication within the user-managed data  
26 processing system ... wherein said at least one advertisement  
27 optionally includes a hyperlink ... ”. (Answer 9).

28 30. The Examiner finds that “[i]t would have been obvious to one of  
29 ordinary skill in the art at the time of Applicant’s invention to include  
30 the aforementioned limitations as disclosed by Bezos within

1 Goldschmitt for the motivation of efficiently marketing and selling  
2 goods ...”. (Answer 9).

3  
4 31. The Examiner further finds that Goldschmitt and Bezos differ from  
5 the claimed subject matter because

6 Goldschmitt and Bezos do not explicitly disclose:

- 7 • locating a data file containing signature information
- 8 on the data processing system associated with the
- 9 sending party, said signature information being
- 10 appended to electronic communications originating
- 11 from the user managed data processing system
- 12 associated with the sending party;
- 13 • modifying information stored within said signature
- 14 file to include an advertisement; and
- 15 • said electronic communication including said
- 16 information stored within said signature file including
- 17 said advertisement.

18  
19 (Answer 10).

20 32. The Examiner finds that “Uomini discloses an electronic messaging  
21 system that attaches information to the mail messages... [, and a]  
22 signature block (i.e. context data) is used to transmit information to  
23 the recipient and is attached to the sender’s message ... [where] the  
24 signature block may contain business information (i.e. advertisement)  
25 ... ,” relying on column 1, ll. 8-10; column 3, ll. 1-5; and, column 5,  
26 ll. 6-18. (Answer 10).

27 32. The Examiner finds that

28 [i]t would have been obvious to one of ordinary skill in the art at the  
29 time of Applicant’s invention to include locating a data file  
30 containing signature information on the data processing system

1 associated with the sending party, said signature information being  
2 appended to electronic communications originating from the data  
3 processing system associated with the sending party, modifying  
4 information stored within said signature file to include an  
5 advertisement and said electronic communication including said  
6 information stored within said signature file including said  
7 advertisement as disclosed by Uomini within the Goldschmitt and  
8 Bezos system for the motivation stated above [i.e., “to attach  
9 information to the mail message,” Answer 10].

10  
11 (Answer 10-11).

12  
13 33. Appellant argues that "Uomini does not suggest or motivate  
14 modifying the information stored in the signature file to include an  
15 advertisement ... ." (Brief 16).

16  
17 PRINCIPLES OF LAW

18  
19 1. A *prima facie* case of obviousness is established by presenting  
20 evidence that would have led one of ordinary skill in the art to combine the  
21 relevant teachings of the references to arrive at the claimed invention. See  
22 *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)  
23 and *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

24 2. “The *prima facie* case is a procedural tool of patent examination,  
25 allocating the burdens of going forward as between examiner and applicant.  
26 *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir.  
27 1990). The term “*prima facie* case” refers only to the initial examination  
28 step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.

1 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA  
2 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden,  
3 on review of the prior art or on any other ground, of presenting a *prima*  
4 *facie* case of unpatentability. If that burden is met, the burden of coming  
5 forward with evidence or argument shifts to the applicant.” *In re Oetiker*,  
6 977 F.2d, 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

7 3. Claims are given the broadest reasonable construction consistent with  
8 the Specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023,  
9 1027 (Fed. Cir. 1997).

10 4. The goal of claim construction is “to interpret what the patentee  
11 meant by a particular term or phrase in a claim.” *Renishaw PLC v. Marposs*  
12 *Societa’ per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed Cir  
13 1998).

14 5. In interpreting what Appellant means by a particular term or phrase,  
15 the Board looks first at the claim.

16 The claims of the patent provide the concise formal definition of the  
17 invention. They are the numbered paragraphs which “particularly  
18 [point] out and distinctly [claim] the subject matter which the  
19 applicant regards as his invention.” 35 USC §112. It is to these  
20 wordings that one must look to determine whether there has been  
21 infringement. Courts can neither broaden nor narrow the claims to  
22 give the patentee something different than what he has set forth. No  
23 matter how great the temptations of fairness or policy making, courts  
24 do not rework claims. They only interpret them.

25  
26 *El Du Pont de Nemours & co v. Phillips Petroleum Co*, 849 F.2d 1430,  
27 1433, 7 USPQ2d 1129, 1131 (Fed Cir 1988).  
28  
29

6. “Absent a special and particular definition created by the patent applicant, terms in a claim are to be given their ordinary and accustomed meaning.” *York Prods, Inc v. Central Tractor Farm & Family Ctr*, 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622-23 (Fed Cir 1996).

7. “[I]t is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.” *Vitronics Corp v. Conceptronic, Inc*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed Cir 1996).

8. “The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

## ANALYSIS

### Re the rejection of Claim 1

We have carefully reviewed the record and find that Appellant has not shown that the Examiner erred in concluding that a prima facie case of obviousness is made by the prior art for the subject matter of claim 1. Moreover, after giving claim 1 the broadest reasonable construction consistent with the Specification, we find claim 1 reads on Goldschmitt alone.

1       We begin our analysis with the claim. Claims define that which  
2   Appellant regards to be his invention. *In re Moore*, 439 F.2d 1232, 1235,  
3   169 USPQ 236, 238 (CCPA 1971).

4       A disagreement about the scope of the claim underlies the differing  
5   positions taken in the Answer and the Brief on the question of the  
6   obviousness of the claim over the prior art. However, neither the Examiner  
7   nor Appellant has taken the step of clearly explaining their view of the  
8   scope that should be given the claim. Appellant indicates that the Examiner  
9   has not accurately assessed the differences between what is claimed and  
10   what Goldschmitt discloses, suggesting that the Examiner has misconstrued  
11   the scope of the claim. FF 15. According to the Examiner, claim 1 includes  
12   steps of “*embedding* the advertisement within the communication” and  
13   “associating the preselected advertisement with said communication within  
14   the *user-managed* data processing system.” But the words “embedding”  
15   and “user-managed” do not appear in claim 1. Accordingly, as Appellant  
16   suggests, the Examiner has given claim 1 a scope more narrow than it is  
17   warranted from a plain reading of the claim. However, apart from  
18   indicating that the Examiner has not accurately assessed the differences  
19   between what is claimed and what Goldschmitt discloses, Appellant has not  
20   dissuaded the Examiner from giving the claim an overly-narrow breadth of  
21   scope.<sup>3</sup> Examiner’s position is identical to the one taken at the start of the

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<sup>3</sup> Appellant has instead made an effort to persuade the Examiner that the claim patentably distinguishes over Bezos. The Brief (pp. 7-11) presents a history of that effort.

1 prosecution of this application<sup>4</sup> and repeated in numerous non-final Office  
2 actions<sup>5</sup> and Final Rejections<sup>6</sup> since and yet never do we find Appellant  
3 explaining to the Examiner that the claim is broader than the Examiner  
4 believes it to be. In fact, except for a single conclusory sentence in the Brief  
5 to the effect that Goldschmitt does not disclose all the claimed limitations  
6 (FF 16), Goldschmitt is not otherwise discussed. All the attention is on  
7 Bezos, giving the impression that Appellant not only agrees with the  
8 Examiner's narrow construction of the claim but also goes further, urging an  
9 even more narrow construction for the claim. For the following reasons, in  
10 contradistinction to the constructions Appellant and the Examiner have  
11 given the claim, we construe the claim more broadly.

12       The term "embedded" appears in the last step of the claimed method:  
13 "transmitting said communication with said at least one advertisement  
14 *embedded* therein to the recipient."

15       The ordinary and customary meaning of the word "embed" is to set or  
16 fix firmly in place.<sup>7</sup> Appellant does not point to a definition for "embed" in  
17 the specification, nor can we find any, which gives the word a meaning  
18 inconsistent with this ordinary and customary meaning.

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<sup>4</sup> See non-final Office action mailed 13 February 2001 (p. 2).

<sup>5</sup> See non-final Office actions 10 April 2002 (pp. 2-3), 6 November 2002 (p. 3), 4 December 2003 (p. 3), and 26 January 2004 (p. 3).

<sup>6</sup> See Final Rejections mailed 6 November 2001 (pp. 5-6), 9 May 2003 (p. 9), 9 September 2004 (p. 3), and 1 April 2005 (pp. 2-3).

<sup>7</sup> *Webster's New World Dictionary*, Third College Edition, 1988, p. 442, definition 2.

1           Furthermore, one of ordinary skill in the art reading the claim as a  
2 whole would understand the phrase “advertisement embedded therein” as  
3 describing the result obtained from the claim’s previous step, i.e.,  
4 “associating at least one pre-selected advertisement with said  
5 communication within the data processing system of the sending party.” The  
6 advertisement “embedded” in the communication per the claimed method  
7 results from (a) *associating* the advertisement with the communication and  
8 (b) doing so “*within* the data processing system of the sending party.”

9           The plain meaning of the word “associating” to one of ordinary skill  
10 in the art is an act of joining together, combining or connecting one thing  
11 with another. The Specification does not define “associating” inconsistent  
12 with the plain meaning of the word. Accordingly, in reading the claim as a  
13 whole, one of ordinary skill in the art would understand the phrase  
14 “associating at least one pre-selected advertisement with said  
15 communication” to mean joining together, combining or connecting pre-  
16 selected advertising information with communicating information. Any  
17 method joining together, combining or connecting a pre-selected  
18 advertisement with a communication *associates* the advertisement with the  
19 communication.

20           Goldschmitt describes a method of transmitting an advertisement by  
21 email wherein the advertisement is appended to the email message and both  
22 the email and the appended advertisement are transmitted to the addressee  
23 for viewing. FF 5. Because appending an advertisement to an email causes  
24 the advertisement to join together, combine or connect the advertisement  
25 with the communication, Goldschmitt discloses the step of “associating at



1 least one pre-selected advertisement with said communication.” It follows  
2 from this that Goldschmitt moreover discloses, per the claim, “transmitting  
3 said communication with said at least one advertisement *embedded* therein  
4 to the recipient” *if* Goldschmitt also further discloses conducting the  
5 appending procedure “*within* the data processing system of the sending  
6 party.”

7 Before we determine whether Goldschmitt also further discloses  
8 conducting the appending procedure “*within* the data processing system of  
9 the sending party” in accordance with the claim, we construe the first step of  
10 the claim: "initiating a communication from a data processing system of a  
11 sending party." The plain meaning of "initiating" is an act of starting. The  
12 specification does not give the term a meaning inconsistent with its plain  
13 meaning. One of ordinary skill in the art reading the claim as a whole  
14 would understand "initiating" to mean starting a communication, the same  
15 communication which, as described later in the claim, will be joined  
16 together, combined or connected with a pre-selected advertisement. Given  
17 its broadest reasonable construction consistent with the Specification, this  
18 step simply calls for a sending party's data processing system to start a  
19 communication.

20 The plain meaning of “within” to one of ordinary skill in the art is  
21 inside of something. The Specification does not define “within”  
22 inconsistent with this plain meaning of the word. The phrase “within the  
23 data processing system of the sending party” therefore refers to the inside or  
24 interior of a sending party’s data processing system. The “sending party” is  
25 the same "sending party" referred to in the first step of the claim discussed

1 above. Therefore, the step of “associating at least one pre-selected  
2 advertisement with said communication within the data processing system  
3 of the sending party” is construed to mean joining together, combining or  
4 connecting pre-selected advertising information with communicating  
5 information inside a sending party’s data processing system.

6 That leaves the question of the scope to be given the phrase “*the data*  
7 *processing system* of the sending party.” Clearly, this refers to an  
8 information-manipulating system or apparatus. The *type* of information-  
9 manipulating system or apparatus is left open. The Specification mentions  
10 as examples workstations and servers (Specification 5:5-6) and even devices  
11 accessing an external server such as an internet based server from which  
12 advertising information is obtained for inclusion in the originated message  
13 (Specification 5:18-20). Therefore, in light of the Specification, one of  
14 ordinary skill would construe the phrase “*the data processing system* of the  
15 sending party” to cover a broad range of information-manipulating systems  
16 ranging from, with respect to manipulating electronic information, a home  
17 computer to computer networks.

18 In accordance with the Goldschmitt process, a subscriber initiates a  
19 communication, a server receives the communication, appends an  
20 advertisement thereto and transmits the combination to the recipient. All  
21 this occurs within the “sending party’s” network, the “sending party”  
22 comprising the subscriber who sends the communication and an entity  
23 operating the server with whom the subscriber has agreed may append an  
24 advertisement to the subscriber’s communication. We find therefore that  
25 Goldschmitt discloses conducting the appending procedure “*within* the data

1 processing system of the sending party” in accordance with the claim. Since  
2 Goldschmitt discloses the step of “associating at least one pre-selected  
3 advertisement with said communication,” as earlier explained, it follows  
4 that Goldschmitt describes the step of “transmitting said communication  
5 with said at least one advertisement *embedded* therein to the recipient.”

6 Accordingly, giving the claim the broadest reasonable construction  
7 consistent with the Specification, we find that the claimed method reads on  
8 Goldschmitt's described method.

9 As a result, the Examiner's reliance on Bezos to reject the claim as  
10 unpatentable over the prior was not necessary. Accordingly, we will not  
11 address it or Appellant's arguments challenging it.

12 The rejection of claim 1, and claims 2-19, 22, 23, and 25 standing or  
13 falling with claim 1, is affirmed.

14  
15 Re the rejection of Claim 24

16 Claim 24 differs from claim 1 only in that the pre-selected  
17 advertisement is further defined to be "under the local control of the sending  
18 party." The purpose of limiting the pre-selected advertisement to one which  
19 is "under the local control of the sending party" is to contrast the method  
20 claimed from that of Goldschmitt which, according to Appellant, involves  
21 "appending of an advertisement to an email .... performed at a remote server  
22 associated with the sponsors" FF 25.

23 However, because the Specification does not give the term "local" a  
24 definition different from its plain meaning, the plain meaning being a  
25 particular area, limiting the pre-selected advertisement to one which is

1 "under the local control of the sending party" does little to distinguish the  
2 method claimed over that of Goldschmitt. Given the breadth of the phrase  
3 "local control," the claim broadly encompasses a "sending party"  
4 conducting the actions of both an email subscriber sending a  
5 communication and a remote entity operating a server with whom the  
6 subscriber has agreed may append an advertisement to the subscriber's  
7 email, an arrangement Goldschmitt discloses.

8 Even if we were to construe, arguendo, the phrase "under the local  
9 control of the sending party" to mean the step of associating the  
10 advertisement is conducted within the very computer a user uses to send a  
11 communication, thereby excluding using a remote server under someone  
12 else's control,<sup>8</sup> the method claimed would nevertheless have been obvious  
13 to one of ordinary skill in the art reading Goldschmitt at the time of the  
14 invention. An arrangement by which one user handles all the tasks of  
15 initiating a communication, appending an advertisement to the  
16 communication and sending the combination to a recipient is an expedient  
17 one of ordinary skill in the art practicing the Goldschmitt process would  
18 readily foresee. In fact, if the claim were to be so construed it would read  
19 on SPAM, i.e., unsolicited commercial email; something Appellant has

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<sup>8</sup> The prosecution history shows Appellant attempting to limit the scope of the claim so that the step of associating the advertisement with the communication is conducted by the very user initiating and sending the communication. At one point the step was limited to the "user-managed" data processing system but that limitation, and others similar thereto, no longer appear in claims 1 and 24. See, e.g., the amendment filed 12 August 2003.

1 admitted is old in the art (Specification 3) and a commercial but common  
2 application for the typical process of sending an email with an attachment  
3 (see Goldschmitt's Background discussion (p. 1)).

4 Accordingly, after giving the claim the broadest reasonable  
5 construction consistent with the Specification, the claimed subject matter is  
6 not patentably distinguishable from the method Goldschmitt discloses.

7 As a result, the Examiner's reliance on Bezos to reject the claim as  
8 unpatentable over the prior was not necessary. Accordingly, we will not  
9 address it or Appellant's arguments challenging it.

10 The rejection of claim 24 is affirmed.

11  
12 Re the rejection of Claim 20

13 We will also affirm this rejection.

14 The Examiner relies on Uomini as evidence that the steps of

15 locating a data file containing signature information on the data  
16 processing system of the sending party, said signature information  
17 being appended to electronic communications originating from the  
18 sender's data processing system; [and,]

19 modifying the information stored within said signature file to  
20 include at least one advertisement,

21  
22 recited in claim 20, were known in the prior art. FF 32. The Examiner  
23 characterizes Uomini as disclosing a system that attaches a signature block  
24 containing, for example, name and address to an electronic communication.  
25 FF 32. To be accurate, Uomini is directed to a method of obtaining the  
26 context information (name, address, etc.) of an email. (Uomini, col. 2, ll. 56-  
27 62). Uomini seeks to improve on the need to use such bandwidth-wasting

1 methods as attaching a business card (i.e., a "vCard") to provide an email's  
2 context information (Uomini, col. 2) by, for example, searching the message  
3 itself for the existence of any context information (Uomini, col. 6, ll. 58-59).  
4 Notwithstanding the improvement, Uomini does disclose it is known in the  
5 prior art to attach signature information to an email in the form of a business  
6 card. A business card normally contains a name, address and other relevant  
7 business information, including advertising information (e.g., logo). One of  
8 ordinary skill in the art would understand an electronic business card to be  
9 one which a user locates and modifies as changes to the information become  
10 necessary. In view of Uomini, one of ordinary skill in the art would have  
11 been led to append user information, including business cards with relevant  
12 advertising information, to a communication. A preponderance of the  
13 evidence suggests that one of ordinary skill in the art would have been led  
14 to combine Goldschmitt's disclosure (see Background, p. 1) of appending  
15 attachments to emails with Uomini's disclosure of appending business cards  
16 to arrive at the claimed invention involving appending signature  
17 information with advertising information to an electronic communication.  
18 *A prima facie* case of obviousness has thus been established. *In re Kahn*,  
19 441 F.3d 977, 985, 78 USPQ2d 1329, 1338 (Fed. Cir. 2006)

20 Appellant argues that "vCards cannot be and are not inserted or  
21 embedded into an email signature file." Brief 17. The difficulty with this  
22 argument is two-fold.

23 First, the claim makes no mention of inserting or embedding as  
24 Appellant argues. Claim 20 simply calls for locating a data file which  
25 contains signature information to be appended to an electronic

1 communication, modifying it to include advertising information, and  
2 transmitting the communication/signature/advertisement combination. In  
3 our view, one of ordinary skill in the art would have been led to combine the  
4 relevant teachings of the references to arrive at these steps.

5 Second, to accept Appellant's argument we would have to conclude  
6 that one of ordinary skill in the art would construe "signature file" to be  
7 something that electronically-attached business cards are not, namely a data  
8 file instructed to place signature information in an email message.

9 However, the claim does not define "signature file" to be anything more  
10 than "a data file containing signature information on the data processing  
11 system of the sending party." The specification does not provide a  
12 definition any more precise. The relevant disclosure can be found on pages  
13 14 and 15 of the Specification. There it merely states, in part, that "[i]n the  
14 event that the user already includes a signature having, for example, his  
15 name and address, then the advertisement would be added to this  
16 information and placed directly below this user information" (Specification  
17 14). Consistent with this disclosure, the broadest reasonable construction to  
18 be given "signature file" as used in the claim as interpreted by one of  
19 ordinary skill in the art would be an electronic file containing data about the  
20 user. Since the business card Uomini discloses is such a data file, we agree  
21 with the Examiner that Uomini discloses a "signature file."

22 Accordingly, we do not find Appellant's argument persuasive as to  
23 error in the rejection and therefore affirm the rejection of claim 20, as well  
24 as claims 21 and 26 standing or falling with claim 20.

CONCLUSION OF LAW

On the record before us, the Examiner's evidence and rationale is sufficient to make out a prima facie case of obviousness under 35 U.S.C. § 103(a) for claims 1-26. On the record before us, Appellant has not shown that the Examiner erred in concluding that a prima facie case of obviousness for these claims is made by the prior art disclosures.

DECISION

The Examiner's rejection of claims 1-26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

hh

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